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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,330	08/04/2003	Harald Kloeckner	FA1144USNA	6775

23906 7590 04/04/2006

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WILMINGTON, DE 19805

EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/634,330	Applicant(s) KLOECKNER ET AL.	
	Examiner Elena Tsoy	Art Unit 1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 2-6 and 8-18.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☒ Other: Note the attached PTO-892.

Art Unit: 1762

Advisory Action

1. The amendment filed on 3/24/2006 under 37 CFR 1.116 in reply to the final rejection has been entered because limitations of claim 7 now are inserted into independent claims 2 and 3. However, the amendment is not deemed to place the application in condition for allowance for the reasons of record as set forth in the Final Office Action mailed on 1/18/2006, and because Hellmann et al teach that their coating compositions are particularly suitable for use as **primers** for *plastics* surfaces and, are particularly suitable for the painting and repair of **motor vehicles** and motor vehicle parts having plastics surfaces (See column 3, lines 9-16). Hellmann et al also teach that the paint coatings may be applied by three-coat process (See column 3, lines 17-18). **As a primer**, the coating composition according to the invention is applied, for example, by spraying to the substrate to be painted. Subsequent drying in air, for example for about 20 minutes, is sufficient, although oven drying is also possible. **Typical finishing paints**, for example *typical car repair paints*, then are applied to the coating obtained (See column 3, lines 26-29). One of ordinary skill in the car painting art would easily recognize that typical car three-coat finishing paints include a primer (pigmented or non-pigmented), a colored basecoat and a clear top coat. Therefore, limitations of amended claims 2 and 3 are covered by Hellmann et al.

Response to Amendment

2. Amendment filed on 3/24/2006 has been entered. Claim 7 has been cancelled. Claims 2-6, and 8-18 are pending in the application.

Response to Arguments

3. Applicants' arguments filed 3/24/2006 have been fully considered but they are not persuasive.

Art Unit: 1762

(A) Applicants argue that Hellmann is directed toward primers that are applied to the plastic substrate. Applicants' applied compositions are not primers but properly formulated base coats or mono-coats (top-coats).

The Examiner respectfully disagrees with this argument. One of ordinary skill in the car painting art knows that a basecoat and a primer are used interchangeably, e.g. a basecoat applied directly to a substrate is a primer, as evidenced by US 5258460 to Faul et al (See column 3, line 58); or the same coating composition pigmented with conventional pigments can be used as a monocoat or as basecoat or as a primer, as evidenced by US 5859136 to Scopazzi et al (See column 3, lines 39-42); or a primer applied directly to a substrate is a basecoat, as evidenced by US 4572792 to Muller (See column 3, line 68).

Therefore, Hellmann' primers can be interpreted as basecoats.

(B) Applicants argue that since Hellmann is directed to primers, Hellmann only uses epoxy resins as a binder component whereas Applicants claims exclude epoxy resins. Epoxy resins can not be used as topcoats (mono-coats) or base coats since these resins are readily degraded by UV light. Applicants have amended the claims to use only binder components that are stable to UV light exposure and weathering. The binder components set forth in the claims are from the group of polyurethanes, acrylated polyurethanes, polyacrylates, polyesters, acrylated polyesters or alkyd resins and do not include epoxy resins.

The Examiner respectfully disagrees with this argument. First of all Applicants claims do NOT exclude epoxy resins. The composition of Claim 2 **comprises** claimed components, i.e. does not exclude other components, and does not recite a negative limitation excluding "epoxy resins".

(C) Applicants argue that primers do not contain the pigments that are required to provide the desired colour to the painted plastic pad. By applying two base coats or topcoats

Art Unit: 1762

(mono-coats) Applicants have eliminated the primer layer that is required by Hellmann and are able to form a finish with more distinct and clear color than is possible with the only the application of a single base coat or top coat. This is not taught by Hellmann or the other references.

The Examiner respectfully disagrees with this argument. First of all, one of ordinary skill in the art knows that primers may contain pigments; and secondly, Hellmann does teach a pigmented coating composition which is used as a primer.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-142323. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

March 30, 2006

ELENA TSOY
PRIMARY EXAMINER
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